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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/611,556	07/02/2003	Laure Simonot	033818-003	6002

7590 07/15/2004

HAROLD R. BROWN III
BURNS, DOANE, SWECKER & MATHIS, L.L.P.
P. O. Box 1404
Alexandria, VA 22313-1404

EXAMINER

WYROZEBSKI LEE, KATARZYNA I

ART UNIT	PAPER NUMBER
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1734

DATE MAILED: 07/15/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/611,556

Applicant(s)

SIMONOT ET AL.

Examiner

Katarzyna Wyrozebski

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 21 April 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-80 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-80 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

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In view of the applicants response mailed on 4/21/2004 following final office action is necessitated.

Claim Rejections - 35 USC § 102

1. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

2. Claims 1, 2, 4, 5, 7-19, 21, 22, 24-34, 36, 37, 39-49, 51, 52, 54-80 are rejected under 35 U.S.C. 102(e) as being anticipated by WANG (US 6,469,089).

The discussion of the disclosure of the prior art of WANG from paragraph 2 of the office action mailed on 11/25/2003 is incorporated here by reference. Newly added claims directed to the particle size and BET surface of SiC are also rejectable by the prior art of WANG.

3. Claims 1-80 are rejected under 35 U.S.C. 102(e) as being anticipated by VISEL (US 6,121,346) in view of evidence given in WANG (US 6,469,089).

The discussion of the disclosure of the prior art of VISEL from paragraph 3 of the office action mailed on 11/25/2003 is incorporated here by reference. Newly added claims directed to the particle size and BET surface of SiC are also rejectable by the prior art of VISEL.

Claim Rejections - 35 USC § 103

4. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

5. Claims 3, 6, 20, 23, 35, 38, 50, 53 are rejected under 35 U.S.C. 103(a) as being unpatentable over WANG (US 6,469,089) in view of VISEL (US 6,121,346).

The discussion of the disclosure of the prior art of WANG and VISEL from paragraph 7 of the office action mailed on 11/25/2003 is incorporated here by reference. Newly added claims directed to the particle size and BET surface of SiC are also rejectable by the prior art of WANG and VISEL.

6. In the response mailed on 4/21/2004 the applicants argued the following:

a) The reinforcing filler of WANG consists of carbon black as shown in the examples of the prior art. It is clear from WANG that the SiC is not utilized as reinforcing filler, in addition when utilized with carbon black, the amount of the carbon black is greater than the amount of SiC.

With respect to the above argument, the examiner would like to point out that the prior art of WANG is not limited to carbon black only. In fact claim 15 of WANG discloses that the filler utilized in conjunction with SiC can be silica. Therefore carbon black per claims 14 and 15

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of WANG does not have to be utilized. With respect to the examples that the applicants are referring to, the examiner cannot rely on the examples alone to make a case. An entire disclosure has to be considered.

With respect to the applicants argument, stating that the SiC of WANG is not utilized as reinforcing filler, it is not clear as to what exactly the applicants are trying to convey. Especially, when the applicants in their own claims disclose use of reinforcing filler and inorganic filler comprising SiC.

b) The prior art of WANG does not teach the particle size of the SiC.

Reviewing applicants response with respect to the particle size of the SiC of WANG attached is a product data sheet for the PT and BPT lots made by Nanomaterials Research Corporation out of Longmont Colorado as depicted under Table I of WANG. The data sheet discloses that the BPT lots have particle size of 3-25 nm and PT lots have particle size of 25-250 nm, which encompasses particle size required by the present invention.

c) The prior art of VISEL merely discloses concept of using as a filler in a rubber composition smaller particles grafted onto the surface of the larger particles without teaching or suggesting any advantages of SiC nor giving working examples.

With respect to this argument, working examples are not required in order for the prior art to be applicable as a 102 reference against present claims. VISEL may “merely” disclose small particles, but it does teach or suggest them and it does specifically name silicon carbide.

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d) There is no reason why one of ordinary skill in the art would look into WANG to provide for deficiencies of VISEL.

With respect to the above argument, in the 102 rejection, the prior art of WANG was utilized as an evidence supporting examiner's allegation about the BET surface of the SiC and not as a rejection.

With respect to the 103 rejection WANG and VISEL were combined, since they teach rubber composition that can be molded into an article such as tire (col. 8, line 62-65 of VISEL and col. 1, line 47 of WANG) therefore they are in the same field of endeavor. In fact wet-skid resistance (WANG) is property that is highly desirable in tires VISEL.

e) The prior art of VISEL does not teach the particle size and surface area of silicon carbide of the present invention.

With respect to the above argument the applicants are requested to again review the examiner's first office action on the merits, which discloses where the prior art of VISEL teaches particle size (col. 5, lines 9-12) and teaching of evidence in WANG (BET surfaces).

7. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after

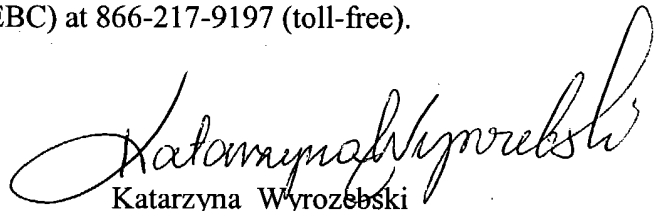
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the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Katarzyna Wyrozubski whose telephone number is (571) 272-1127. The examiner can normally be reached on Mon-Thurs 6:30 AM-4:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Vasu Jagannathan can be reached on (571) 272-1119. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).


Katarzyna Wyrozubski
Primary Examiner
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July 1, 2004